



AF/GAU 3738

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DOCKET NO. PRESBY 20018

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: : J.T. Lin  
Serial No. : 09/189,609  
Filed : November 1998  
Group Art Unit : 3738  
Primary Examiner : Dinh X. Nguyen

BOX AF  
Assistant Commissioner for Patents  
Washington, D. C. 20231

**CERTIFICATE OF EXPRESS MAILING**  
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I certify that this correspondence is being deposited with the United States Postal Service as "Express Mail, Post Office to Addressee" in an envelope with sufficient postage addressed to: BOX AF, Assistant Commissioner for Patents, Washington, D.C. 20231, on April 27, 2001.  
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Sir:

**PROTEST UNDER 37 C.F.R. § 1.291**

This protest is being filed in the above-identified application pursuant to 37 C.F.R. § 1.291 on behalf of RAS HOLDING CORP and PRESBY CORP (collectively, "Protester") based upon information within a March 27, 2001 press release by SURGILIGHT INC., available at:

**[www.surgilight.com/news/march2701.htm](http://www.surgilight.com/news/march2701.htm)**

a copy of which is attached and incorporated herein by reference for all purposes.

Although a Notice of Allowance has apparently been mailed in the above-identified application, Protester respectfully notes that Patent Office policy states:

A protest submitted after the mailing of the notice of allowance will not knowingly be ignored if the protest includes prior art documents which clearly anticipate or clearly render obvious one or more claims.

MPEP § 1901.04.

#### LISTING OF PATENTS RELIED UPON

This protest is filed based on the following patents:

<u>Patent No.</u>	<u>Inventor(s)</u>	<u>Issue Date</u>	<u>Filing Date</u>
5,489,299	Schachar	02-06-1996	07-15-1992
5,984,916	Lai	11-16-1999	04-20-1993
5,997,529	Tang et al	12-07-1999	10-28-1996
6,010,497	Tang et al	01-04-2000	01-07-1998
6,132,424	Tang	10-17-2000	03-13-1998
6,190,374	Amano et al	02-20-2001	11-25-1997
6,210,401	Lai	04-03-2001	11-06-1991

Copies of each of the listed patents are enclosed. Each of the listed patents is a prior art reference to the above-identified application under one or more of 35 U.S.C. §§ 102(a), 102(b), 102(e) and 103.

### RELEVANCE OF LISTED PATENTS

The SurgiLight press release identified above indicates that the allowed claims are directed to laser correction of presbyopia by expansion of the sclera. *Schachar* teaches correction of presbyopia by expansion of the sclera, and specifically teaches that internal ocular pressure (IOP) will cause such expansion when a laser is employed to weaken the sclera:

If the sclera is weakened in the area adjacent to the ciliary body, the IOP will cause that portion of the sclera to bulge outward, . . . . The sclera may be thinned or weakened by the surgical removal of a portion of its collagenous substance, as, for example, by ablating a portion of the thickness of the sclera. This thinning can be accomplished by paring or by abrading the surface or by ablating the surface with laser irradiation.

*Schachar*, column 7, lines 32-34 and 54-59. *Schachar* thus anticipates laser correction of presbyopia.

While *Schachar* discloses a plethora of laser types common or suitable for laser correction of presbyopia, it was thought prudent to also include the remaining attached references, each of which teaches laser ablation processes on a human eye. *Amano et al*, in particular, addresses laser correction of presbyopia. *Amano et al* discloses a pulsed ablation laser system having a output beam of a wavelength of 193 nm (0.193 microns). *Amano et al*, Figures 1 and 2; column 3, line 65 through column 4, line 4. A lens 14 and mirror 16 within the laser system reduce and focus the laser beam onto the patient's eye. *Amano et al*, Figure 1; column 4, lines 32-35. In correcting presbyopia, the laser beam is moved by controller 20 within a rectangular ablation shape over the surface of the eye, with the ablation shape repeated

within a predetermined area 30. *Amano et al*, Figures 4 and 13A; column 5, lines 34-40 and column 6, lines 41-65. *Amano et al* does not teach that expansion of the sclera results, but instead teaches that dual focal points are created. However, *Schachar* provides a motivation for adapting the process of *Amano et al* to laser ablate--and thereby weaken--the sclera to produce expansion of the sclera.

*Amano et al* also teaches additional techniques in laser correction of presbyopia, such as masking the ablation. *Amano et al*, Figures 16A and 16B; column 1, lines 20-26. The disclosure of the looped ablation shape in Figure 4 of *Amano et al* also suggests employing a ring pattern in ablating/weakening the sclera.

The remaining patents listed above all teach various processes for laser ablation of a human eye, including specific parameters such as: laser wavelength; pulse duration; and spot size, depth, and/or shape. A skilled artisan would be motivated to select appropriate parameters in modifying the specific process disclosed by *Amano et al* as suggested by *Schachar* based upon the teachings of the benefits and motivations for employing such parameters within the respective references.

Accordingly, the patents listed above clearly anticipate or clearly render obvious the invention indicated within SurgiLight's press release to be claimed in the above-identified application. Reconsideration of the allowability of that application is respectfully requested.

**SERVICE**

The undersigned certifies that copies of this protest and the attachments are being served pursuant to 37 C.F.R. § 1.248(a)(4) on the date shown above within the Certificate of Express Mailing via transmission by first class mail to Applicant and Applicant's attorney.

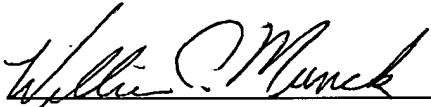
If any issues arise, or if the Examiner has any questions, Protester respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at [wmunck@novakov.com](mailto:wmunck@novakov.com).

The Commissioner is hereby authorized to charge any fees required in connection with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

NOVAKOV DAVIS & MUNCK, P.C.

Date: April 27, 2001

  
\_\_\_\_\_  
William A. Munck  
Registration No. 39,308

900 Three Galleria Tower  
13155 Noel Road  
Dallas, Texas 75240  
(972) 628-3621 (direct dial)  
(214) 922-9221 (main number)  
(214) 969-7557 (fax)  
E-mail: [wmunck@novakov.com](mailto:wmunck@novakov.com)